

REMARKS**Status:**

Claims 1-30 stand rejected. Claims 1-3, 5-6, 8, 14, 20-21, and 25-27 are amended without prejudice to Applicants' ability to file a continuation application, and Claims 24 and 28 are cancelled without prejudice.

Claims 1-23, 25-27, and 29-30 remain pending.

Claim 1 is amended to recite constraining motion of the distal end of an instrument along a predetermined path, and to insert the word "the" to correct a typographical error. Claims 2, 3, 6, and 8 are amended to reflect the recitation of "constraining". Claim 14 is amended to recite the step of cooperating motion of the distal ends of the first and second instruments such that the distal ends follow a predetermined path. Claim 20 is amended to recite constraining motion of the distal end of the flexible instrument along a desired path as the instrument is advanced from the distal end of the instrument panel. Claims 21 and 25-27 are amended to reflect the recitation of "constraining". Support for the amendments is found in the description and drawing as filed. No new matter is added.

102(b) Rejections:

Claims 1-3, 5-8, 20-21, 24-27, and 29 are rejected as anticipated by Mitsui('157). It is respectfully urged that this rejection should be withdrawn for at least the following reasons.

Claim 1 has been amended to recite the step of constraining motion of the distal end of the instrument along a predetermined path. It is respectfully urged that Mitsui ('157) does not teach or suggest such a step. In particular, it is respectfully urged that Mitsui does not constrain motion of the end of an instrument, nor constrain the end of an instrument along a predetermined path. One benefit of such an arrangement is that a tissue site can be repeatably accessed once the endoscope is correctly positioned (see for example page 15, lines 6-29 of the application). In

contrast, Mitsui's Figure 2 and 3 show an instrument being extended, with a distal end of the instrument apparently free of guidance.

In Figures 2, 3, and 5 of Mitsui cited by the examiner, Mitsui shows the tip portion 21a of a forceps that appears to be free to move once the forceps has been extended beyond the control member 27 of Mitsui. It is respectfully urged that the device shown in Figures 2, 3, and 5 of Mitsui does not constrain the distal end of the instrument along a predetermined path at the treatment site.

With respect to Claim 2, it is not clear what portion of the device of Mitsui would restrict twisting of the instrument. The Examiner is respectfully requested to provide an explanation as to how the free tip portion of the forceps in Mitsui is restricted from twisting by the device of Mitsui.

With respect to Claim 6, it is respectfully urged that Mitsui does not teach constraining motion of the end of the instrument along an arc. The Examiner references Figure 3 of Mitsui with regard to rejection of Claim 6, but it is respectfully urged that the tip portion 21a in Figure 3 does not appear to be constrained at all, little less along an arc.

With respect to Claim 20, it is respectfully urged that Mitsui does not show constraining motion of the distal end of a flexible instrument along a desired path as the instrument is advanced from the distal end of the instrument channel. Again, the tip portion 21 in Figure 3 of Mitsui appears to be unconstrained. With respect to Claim 25, it is respectfully urged that Mitsui does not show constraining motion of the end of the instrument along an arc.

With respect to Claim 29, the Examiner's rejection does not appear to apply Mitsui to the steps of Claim 29. Under the heading "Independent Claims 1, 20, 29" in the Examiner Office Action of September 30, 2003, the Examiner does not set forth how Mitsui teaches the steps of Claim 29, including attaching a mechanism for guiding motion of a medical instrument to the distal end of an endoscope; inserting a first instrument having a distal end through an instrument channel of the endoscope; connecting the distal end of the medical instrument to the mechanism; and inserting the endoscope with the mechanism and the medical instrument into the patient. In particular, the Examiner has not indicated how Mitsui teaches connecting the distal end of the medical instrument to the mechanism for guiding the medical instrument. Accordingly, the Examiner is requested to

withdraw this rejection or provide a non-final rejection setting forth a more complete rejection to give the Applicant a full and fair opportunity to respond.

Rejections under 35 USC 102(e):

Claims 1-3, 5-11, 13-17, 20-21, and 24-29 are rejected as anticipated by Matsui et al. ('503). This rejection is improper for at least the following reasons.

With respect to Claim 1, Matsui et al. does not teach or suggest constraining motion of the distal end of an instrument along a predetermined path. With reference to Figures 48-50 and forceps raising base 201 of Matsui et al cited by the Examiner, it is respectfully urged that once the instrument 205 exits the device of Matsui et al., the distal end of the forceps 205 is not constrained, nor constrained to move along a predetermined path at a treatment site.

With respect to Claim 2, it is respectfully urged that Matsui et al. does not provide for restricting twisting of the distal end of forceps 205. The Examiner is respectfully requested to point out what portion of Matsui et al. would prevent twisting of the distal end of the forceps 205 in Matsui et al.

With respect to Claim 6, it is respectfully urged that Matsui et al. does not provide the step of constraining motion of the end of the instrument along an arc at the treatment site. In particular, once the forceps 205 extends from the device of Matsui et al., it is respectfully urged that the distal end of the forceps 205 are not constrained to move along a predetermined path, little less along an arc.

With respect to Claim 10, it is respectfully urged that the Examiner has not shown how Matsui et al. teaches removing tissue through the channel without removing the instrument from the channel. The Examiner references column 18:62-19:5 of Matsui et al., but this reference states that:

“...and, by applying a suction from the first channel 191 to a tissue portion of the diseased portion 223 to suck it into the distal end cap 212 and pulling back on the snare wire with the

tissue portion trapped and tightened, it is possible to supply a high frequency current and cut off the diseased portion 223.”

It is respectfully urged that this portion of Matsui et al. cited by the Examiner does not teach the step of Claim 10 of removing a tissue sample through the channel without removing the instrument from the channel. See the Applicants' description at page 17, columns 20-31 and Figure 7 for an explanation of the step of removing a tissue sample without removing the instrument from the channel.

With respect to Claim 13, it is respectfully urged that Matsui et al. does not show an instrument having a distal end constrained as set forth in Claim 1 and further wherein the instrument comprises a hollow member, and communicating a source of vacuum with the hollow member.

With respect to Claim 14, the Examiner references figures 49 and 50 of Matsui et al. for the purpose of showing cooperating motion. Claim 14, as amended, recites cooperating motion of the distal ends of the first and second instruments such that the distal ends follow a predetermined path. It is respectfully urged that Figures 49 and 50 do not show cooperating motion of the distal ends of two instruments such that the distal ends follow a predetermined path. Instead, Figures 49 and 50 show forceps 205 and knife 206 extending from the side of the device of Matsui et al., without any indication that the distal ends of forceps 205 and knife 206 follow a predetermined path.

With respect to Claim 15, the Examiner states that Matsui et al. depicts cooperating motion comprising engaging the distal ends of the first and second instruments, one with the other in Figures 49 and 50 of Matsui et al. It is respectfully urged that Figures 49 and 50 do not appear to shown the first and second instruments engaged, one with the other. The Examiner is respectfully requested to explain how the instruments in Figures 49 and 50 are engaged, one with the other, as they appear in Figure 49 and 50 to be separated and not in engagement, one with the other.

With respect to Claim 17, the Examiner is respectfully requested to point out what in Matsui et al. teaches or suggests cooperating motion of the distal ends of the forceps 205 and knife 206 to preventing twisting of at least one of the forceps 205 and the knife 206. It is respectfully urged that even if one were to somehow construe Matsui et al. to teach cooperating motion of the distal ends of forceps 205 and knife 206, that the configuration shown in Matsui et al. would not provide cooperating motion of the distal ends comprising preventing of twisting of at least one of the forceps 205 and knife 206.

With respect to amended Claim 20, it is respectfully urged that Matsui et al. does not teach or suggest constraining motion of the distal end of the flexible instrument along a desired path as the instrument is advanced from the distal end of the endoscope. It is respectfully urged that the distal ends of the forceps 205 and knife 206 of Matsui et al. are not constrained to move along a desired path as they are advanced from the endoscope.

With respect to Claim 29, the rejection is improper for the reasons set forth above with respect to Mitsui. It is respectfully urged that the Examiner has not applied the Matsui et al. reference to each of the steps set forth in Claim 29. Accordingly, the rejection should be withdrawn, or the Examiner is requested to provide a non-final rejection setting forth the rejection in full so that the Applicants have a full and fair opportunity to respond.

103 Rejections:

Claims 4, 18, 19, and 22-23 are rejected as obvious as unpatentable over Mitsui or Matsui et al. The Examiner's only explanation for this rejection is:

"Optimal bending angles would have been determined through routine experimentation."

It is respectfully urged that this rejection is improper for at least the following reasons.

First, the rejection of Claim 4 is improper for the reasons set forth above with respect to Claim 1, from which Claim 4 depends. Likewise, the rejection of Claims 18 and 19 is improper for all the reasons set forth above with respect to Claim 14 from which Claim 18 and Claim 19 (through Claim 18) depend, and the rejection of Claims 22 and 23 is improper for the reasons set forth above with respect to Claim 20.

Further, the Examiner has failed to set forth a prima facie case of obviousness. The Examiner is required to provide motivation in the prior art for modifying the prior art references, the modification must have a reasonable expectation of success, and the resulting modification must teach all the limitations of the claim in question. The motivation to make the combination must come from the prior art, not the applicants' disclosure.

The Examiner has not provided any motivation in the prior art to modify Mitsui or Matsui et al. Instead, the Examiner merely states, without providing any explanation or support, that the limitations of Claims 18 and 19 are merely optimization. However, it is not clear how the Examiner comes to this conclusion, because it is not clear that there is a need to "optimize" Mitsui or Matsui et al., except perhaps based on improper hindsight reliance on the Applicants' disclosure. The Examiner is respectfully requested to explain the motivation for "optimizing" either reference.

Also, regarding the required expectation of success, it is not clear that Mitsui could be "optimized" to provide bending through an angle of at least 90 degrees, without otherwise modifying the structure of Mitsui et al. Likewise, it is not clear that Matsui et al. could be "optimized" to provide bending through an angle of at least about 180 degrees, without otherwise modifying the structure of Matsui et al. It is respectfully urged that there can be no motivation to optimize a reference when the optimization would require modifying the structure of the reference.

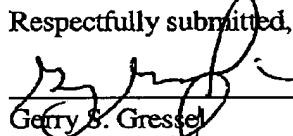
Claim 12 is rejected as unpatentable over Mitsui in view of Farin et al. It is respectfully urged that this rejection is improper for the reasons set forth above with respect to Claim 1, from which Claim 12 depends.

Claim 30 is rejected as unpatenable over Mitsui in view of Wilk et al. This rejection is improper for the reasons set forth above with respect to Claim 29, from which Claim 30 depends.

Conclusion:

The Examiner is respectfully requested to reconsider the application in view of the Remarks above and any amendments. Please call Gerry Gressel at 513 337 3535 with any questions.

Respectfully submitted,


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